

Turning now to the new double patenting rejection, Applicants respectfully traverse the rejection under 35 U.S.C. §101, as the claimed invention is not the same as that claimed in the ‘950 patent. In determining what invention is defined by a claim, all of the recitations in the claim must be considered, and not just a feature of the claim that someone may view as rendering it patentable. Thus, in comparing two claims to determine whether they both claim the same invention, it is improper to compare the “inventive feature” or “gist” of one claim with the “inventive feature” of the other claims. *In re Vogel*, 422 F.2d 438, 164 U.S.P.Q. 619 (CCPA 1970). In *In re Vogel*, the court went on to state that “[a] good test, and probably the only objective test, for ‘same invention [type double patenting],’ is whether one of the claims could be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same invention.” Thus, by identifying where one of the claims could be literally infringed without literally infringing the claims of the ‘950 patent, Applicants have effectively pointed out “where a different invention is present” (as the Examiner has requested). *See page 3, lines 2-4 and page 4, lines 11-12 of April 25, 2001 Office Action.*

The claims of the instant application could be literally infringed without infringing the claims of the ‘950 patent. For example, claim 15 of the present invention recites a method for “checking the movement control apparatus to determine whether the command is being correctly performed”. In contrast, claim 16 of the ‘950 patent recites “detecting a malfunction of the motor control circuitry in response to the first motor control command by sensing door movement after the first motor control command is sent”. A device that does not sense door movement to detect if a fault has occurred would not literally infringe claim 1 of the ‘950 patent, but could literally infringe the instant claims. Therefore, the claims do not define the same invention and the “same invention” type double patenting rejection is improper.

Similarly, independent claim 22 of the ‘950 patent calls for “sensing door movement after the first motor control command is sent to detect a malfunction of the motor control circuitry in response to the first motor control command”. A device that does not sense door movement to detect if a fault has occurred would not literally infringe claims 22 of the ‘950

patent, but could literally infringe the instant claims. Therefore, the claims do not define the same invention and the “same invention” type double patenting rejection is improper.

Furthermore, as the court in *In re Vogel* points out, the Examiner should be careful not to confuse the law of double patenting to require that the invention of the instant patent application be a patentably different invention. *See In re Vogel*, at p.440 (“Apparently [the Examiner and the Solicitor] were thinking that ‘invention’ means ‘patentable invention.’ This has not been the language of the law since January 1, 1953). Applicants believe the Examiner, in this case, has mistakenly made a “same invention” type double patenting rejection rather than an “obvious” type double patenting rejection. Indeed, the section of the MPEP that the examiner cites as support for the rejection, MPEP §804.03), pertains to “obvious” type double patenting and not “same invention” type double patenting. More particularly, the U.S. Court of Appeals for the Federal Circuit has noted that *In re Zickendraht*, the case cited in this section of the MPEP, gave rise to the modern understanding of double patenting and the creation of obvious type double patenting, which applies when the difference between the first-patented invention and its variant involves only an unpatentable difference, (e.g., no second patentable invention has been made). *See General Foods Corp. v. Studiengesellschaft Kohle* 972 F.2d 1272, 1280 (Fed. Cir. 1992); and *In re Kaplan* 789 F.2d 1574, 1578 (Fed. Cir. 1986). In such cases, however, the filing of a terminal disclaimer can overcome the double patenting rejection, and Applicants hereby offer to provide the Examiner with such a disclaimer if indeed an “obvious” type double patenting rejection is to be made.

With respect to the Examiner’s comments regarding the types of malfunction detection the Applicants would be “entitled to”, (pages 4-5 of April 25, 2001 Office Action), Applicants wish to point out that “every claim includes within its breadth or scope one or more variant embodiments that are not disclosed in the application” and that “the words in a claim are generally not limited in their meaning by what is shown or disclosed in the specification.” MPEP §§904.01(a) and 2111.01. Therefore, Applicants’ are free to claim the

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invention in any fashion supported by the specification including the use of terms that would cover additional types of malfunction detection.

Accordingly, applicants hereby request reconsideration and allowance of claims 15-18. Accompanying this amendment is an Amendment Transmittal.

Respectfully submitted,
FITCH, EVEN, TABIN & FLANNERY

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Kenneth H. Samples
Registration No. 25,747
Attorney for Applicants

120 South LaSalle Street, Suite 1600
Chicago, Illinois 60603-3406
Telephone: 312-577-7000
Facsimile: 312-577-7007
KHS/EEC/255895